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10/591,609	09/05/2006	Jurgen Meyer	39509-236168	3090
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VENABLE LLP P.O. BOX 34385 WASHINGTON, DC 20043-9998				
EXAMINER				
LOEWE, ROBERT S				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/591,609

Applicant(s)

MEYER ET AL.

Examiner

ROBERT LOEWE

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's arguments/remarks, filed on 3/12/08, have been fully acknowledged.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Bergstrom et al. (US Pat. 6,384,125), and further evidenced by Griffith et al. (US Pat. 5,908,660) and Burns et al. (US Pat. 6,051,672).

Claim 1: Bergstrom et al. teaches a silanized, structurally-modified silica characterized by vinyl silyl groups being fixed to the silica surface and further comprising hydrophobic groups such as dimethylsilyl additionally being fixed to the silica surface (10:40-67 and Table 2). Bergstrom et al. additionally teaches that the surface-modified silicas have a BET surface area of 100 to 500 m²/g (3:57-61), an average particle size of 5-100 nm (claim 3), and a pH range of about 3 to 8 (Table 2). The Office realizes that all of the claimed properties are not positively stated by Bergstrom et al. However, Bergstrom et al. teaches all of the claimed ingredients. Therefore, the claimed physical properties, i.e., the DBP absorption and carbon content would implicitly be achieved by a composition with all the claimed ingredients. If it is the applicant's position that this would not be the case: (1) evidence would need to be provided to support that applicant's position; and (2) it would be the Office's position that the application contains inadequate disclosure that there is no teaching as to how to obtain the claimed properties with only the claimed ingredients.

Further, Bergstrom further teaches that the surface-modified silica is prepared according to US patents 5,908,660 (Griffith et al.) and 6,051,672 (Burns et al.), whose references are incorporated into the teaching of Bergstrom et al. Burns et al. teaches in Table 1, a carbon content of no more than 10% based on the fact that only about 50% of the trimethylsiloxy groups of table 1 is made up of carbon ($16.55\% * 0.50 = 8\%$). The remaining carbon containing species contribute little to the overall carbon content.

While Bergstrom does not teach that the silicas employed therein are pyrogenically produced, this limitation of instant claim 1 is presented as a product-by-process claim. The courts have stated that even though product-by-process claims are limited and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Claim 2: Bergstrom et al. further teaches a process for preparing silanized silica comprising (a) mixing/treating a silica slurry with a mixture of silanizing agents, (b) heat treating the mixture, and (c) purifying by means of mechanical action (10:40-67).

Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Barthel et al. (US application 2003/0138715).

Claim 1: Barthel et al. teaches a process of preparing surface-modified, low-silanol silica by reacting one or more organosilanes with silica (abstract). Barthel et al. teaches that suitable

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silylating agents include vinylalkoxysilanes and alkylalkoxysilanes (paragraph 0039). Barthel et al. further teaches that any desired **mixture** of organosilanes may be used. Barthel et al. additionally teaches that the surface-modified silicas have a BET surface area of 25 to 500 m²/g (paragraph 0123), an average particle size of 5-100 nm (paragraphs 0077 and 120), and a carbon content of 1.7-5.4% (Table 1-1). Barthel et al. further teaches that the starting silica has, for example, a pH of 4.1 (paragraph 0183).

Barthel et al. is silent with regards to the DPB absorption. However, Barthel et al. teaches all of the claimed ingredients. Therefore, the DBP absorption would inherently be achieved by a composition with all the claimed ingredients. If it is the applicant's position that this would not be the case: (1) evidence would need to be provided to support that applicant's position; and (2) it would be the Office's position that the application contains inadequate disclosure that there is no teaching as to how to obtain the claimed properties with only the claimed ingredients.

Claim 2: Barthel et al. teaches a process for producing silanized, structurally modified silica comprising: (a) mixing/treating the pyrogenically prepared silica and silylating agents (paragraph 0050-0057), (b) reacting the pyrogenically prepared silica and silylating agent mixture by heating the mixture (paragraphs 0058-0060), and (c) purifying the silylated silica by means of mechanical action (paragraphs 0061-0067).

Claim 3: Barthel et al. further teaches that the silica can be first sprayed with water and then with the surface-modifying agent (paragraph 0185).

Claim 4: Barthel et al. further teaches that the silica is treated with the surface-modifying agent in vapor form (paragraph 0185). It is the position of the examiner that by introducing the

surface-modifying agent via atomization through a nozzle, Barthel et al. teaches that the surface-modifying agent is introduced in vapor form. One definition of vapor as defined by Merriam-Webster is "diffused matter (as smoke or fog) suspended floating in the air and impairing its transparency". While vapor is also defined as a material in its gaseous state, one could reasonably apply the first definition cited above; therefore Barthel et al. anticipates the limitations of instant claim 4.

Claims 5 and 6: Barthel et al. further teaches many post surface-modification steps can be performed, including grinding and compacting and conditioning (paragraphs 0061-0069).

Claim 7: Barthel et al. further teaches that the silicone rubber can be used as fillers (paragraph 0180).

Claim 8: Barthel et al. further teaches that prior to the heat-treatment step, a mixing step can be performed (residence time of 2.5 hours at 25 °C as taught in paragraph 0187).

Response to Arguments

Applicant's amendments regarding claims 1 and 2 (Bergstrom et al.) have been fully considered but they are not persuasive. Specifically, the amendment of instant claim 1 citing that the

Applicant's arguments regarding claims 1-8 (Barthel et al.) have been fully considered but they are not persuasive. Specifically, Applicants argue that Barthel et al. does not explicitly teach the surface modified silicas of the instant claims (i.e., those which comprise vinyl or vinyl silyl groups as well as hydrophobic groups). However, as noted above, Barthel et al. explicitly teaches that mixtures of hydrophobic silylating agents can be used and explicitly teaches that R¹

can preferably be vinyl (paragraph 0037). Barthel et al. further teaches several species of silylating agents containing vinyl groups and those which contain mono-, di- or trimethylsilyl groups and further teaches that any desired mixture of these silylating agents can be used.

Applicants further argue that Barthel et al. does not teach that the silica is structurally modified and therefore does not anticipate the claimed invention. However, Barthel et al. does explicitly teach the claimed process steps as cited in the rejection above. Because Barthel et al. teaches the same process steps as claimed, it follows that the pyrogenically produced silicas taught by Barthel et al. are inherently structurally modified. Specifically, Barthel et al. teaches that the pyrogenically produced silica is first treated with a surface-modifying agent to form a mixture, then the mixture is heated to allow reaction between the silica and the surface-modifying agent, and then the mixture is purified using mechanical means such as agitation and grinding (paragraphs 0061-0069).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Loewe whose telephone number is (571) 270-3298. The examiner can normally be reached on Monday through Friday from 5:30 AM to 3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Randy Gulakowski/

Supervisory Patent Examiner, Art Unit 1796